

REMARKS

Claims 2, 3, and 5-9 have been canceled and claims 1 and 4 have been amended.

Applicant respectfully requests further examination and reconsideration of claims 1 and 4 now pending in the application.

The last Office Action mailed from the Patent Office on September 12, 2002 has been carefully considered and indicates that:

- the abstract of the disclosure is objected to;
- claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention;
- claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tetenes in view of Nelson et al.;
- claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tetenes in view of Nelson et al. and further in view of Roberts in view of Campbell in view of Juergens;
- claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tetenes in view of Nelson et al., Levey, Campbell, and Juergens and further in view of Roberts;
- claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tetenes in view of Nelson et al. and further in view of Willinger;
- claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tetenes in view of Nelson et al. and Willinger and further in view of Roberts; and
- claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tetenes in view of Nelson et al., Willinger, and Roberts and further in view of Campbell.

In response to the Examiner's objection to the abstract of the disclosure, applicant has replaced the Abstract of the Disclosure section with a replacement Abstract of the Disclosure section that is one paragraph.

In view of replacing the Abstract of the Disclosure section with a replacement Abstract of the Disclosure section that is one paragraph, applicant respectfully submits that the Examiner's grounds for the objection to the abstract of the disclosure are no longer applicable and applicant therefore respectfully requests that the Examiner withdraw this objection.

In response to the Examiner's rejection of claims 1-9 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, applicant respectfully draws the Examiner's attention to FIGURE 1 of the drawing where the drawstring is shown woven through the upper edge of the cylindrical containing component.

In view of the argument presented supra, applicant respectfully submits that the Examiner's grounds for the rejection of claims 1-9 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention are no longer applicable and applicant therefore respectfully requests that the Examiner withdraw this rejection.

In response to the Examiner's rejection of claim 1 under 35 U.S.C. 103(a) as being unpatentable over Tetenes in view of Nelson et al., the Examiner's rejection of claim 2 under 35 U.S.C. 103(a) as being unpatentable over Tetenes in view of Nelson et al. and further in view of Roberts in view of Campbell in view of Juergens, the Examiner's rejection of claims 3-5 under 35 U.S.C. 103(a) as being unpatentable over Tetenes in view of Nelson et al., Levey, Campbell, and Juergens and further in view of Roberts, the

Examiner's rejection of claim 6 under 35 U.S.C. 103(a) as being unpatentable over Tetenes in view of Nelson et al. and further in view of Willinger, the Examiner's rejection of claim 7 under 35 U.S.C. 103(a) as being unpatentable over Tetenes in view of Nelson et al. and Willinger and further in view of Roberts, and the Examiner's rejection of claims 8 and 9 under 35 U.S.C. 103(a) as being unpatentable over Tetenes in view of Nelson et al., Willinger, and Roberts and further in view of Campbell, applicant has:

- canceled claims 2, 3, and 5-9 without prejudice or disclaimer;
- amended claim 1 to include the limitations of canceled claims 2, 3, and 5-9; and
- amended claim 4 to reflect proper dependency.

It was decided by the CCPA in In re Miller, 169 USPQ 597 (CCPA 1971) that each and every limitation of a claim must be met in determining patentability:

"All words in a claim must be considered in judging the patentability of that claim against the prior art." [at 600] [Emphasis added]

In this same regard, the Examiner's attention is respectfully directed to the decisions in In re Fuetterer, 138 USPQ 217 (CCPA 1963); In re Ludke and Sloan, 169 USPQ 563 (CCPA 1971).

When the device for holding a bucket of frozen chum is designed in accordance with the advantageous distinctive features of amended claim 1, *inter alia*:

- the inside of the container is completely enclosed to securely hold what is inside due to the drawstring closing the upper edge of the container;
- the device is allowed to be more effective and efficient in that the chum can pass through the container walls and into the water to attract fish due

to the sheet material having the first plurality of orifices for permitting chum matter to pass through;

- the drawstring is securely held to the sheet material during use due to the sheet material having the second plurality of orifices to thread the drawstring;
- the toroidal sleeve is ensured to be securely attached to the device making the device stronger and more durable due to the toroidal sleeve being fabricated by stitching first and second longitudinal edges of the longitudinal area of the sheet material together;
- the device is made more lightweight and more inexpensive by using plastic instead of other heavier materials such as metals due to the sheet material being made of a flexible plastic material;
- the chum is allowed to be easily removed from the container in that gravity pulls it through the opening without any need for any other outside force due to the orifice in the bottom of the container permitting chum matter to pass through;
- the device is made stronger and more durable for repeated use due to (1) the circular containing component being permanently attached to the container by stitching and (2) welting being sewn between the bottom portion and the lower edge of the cylindrical container;
- the device is made as inexpensive and lightweight as possible due to the sheet material being made from plastic.

The Federal Circuit held that even though the advantageous features of the present invention discussed supra may not have been disclosed and discussed specifically in the specification of the patent application as it was originally filed, they still must be relied upon as evidence of patentability, as was decided in In re Chu, 66 F.3d 292, 36 USPQ.2d 1089 (Fed. Cir. 1995), where the Court held:

"Board of Patent Appeals and
Interferences erred, in
upholding obviousness
rejection of applicant's

claims, by concluding that
claims' disclosure was matter
of "design choice," and that
the applicant's evidence and
arguments to contrary are not
present in specification and
are therefore unpersuasive,
since board is required to
consider totality of record
and is not free to disregard
evidence and arguments
presented by applicants, and
since there is no support for
proposition that evidence
and/or arguments traversing
35 USC 103 rejection must be
contained within
specification, given that
obviousness is determined by
totality of record including,
in some instances most
significantly, evidence and
arguments proffered during
give-and-take of ex parte
patent prosecution." [at 1090]
[Emphasis added]

"Because the Board was
required to consider the
totality of the record, the
Board was not free to
disregard the evidence and
arguments presented by Chu in
response to the obviousness
rejection. Additionally, the
Board erred in apparently
requiring Chu's evidence and
arguments responsive to the
obviousness rejection to be
within his specification in
order to be considered. To
require Chu to include
evidence and arguments in the
specification regarding

whether placement of the SCR catalyst in the bag retainer was a matter of "design choice" would be to require patent applicants to divine the rejections the PTO will proffer when patent applications are filed." [at 1094] [Emphasis added]

"We have found no cases supporting the position that a patent applicant's evidence and/or arguments traversing a 103 rejection must be contained within the specification. There is no logical support for such a proposition as well, given that obviousness is determined by the totality of the record including, in some instances, most significantly, the evidence and arguments proffered during the give-and-take of ex parte patent prosecution." [at 1095] [Emphasis added]

And, even though the present invention may be considered simple and accomplishes only a small – but genuine – improvement by some is not sufficient reason to deny it patent protection, as was decided in Schnell et al. v. The Allbright-Nell Company et al., 146 USPQ 322 (Court of Appeals, Seventh Circuit 1965), where the Court held:

"Device seems simple...in light of patentee's teaching, but it evidently was not...at time of invention; those working in the field did not accomplish patentee's

results: that fact supports conclusion that patentee achieved patentable invention. [at 322] [Emphasis added]

"This now seems simple...in the light of the Schnell teaching, but is was evidently not at all...at the time of the invention. Those working in the field did not accomplish Schnell's results. That fact supports the conclusion that Schnell achieved patentable inventions. Pyle Nat. Co. v. Lewin, 7 Cir., 1937, 92 F.2d 628, 630, 35 USPQ 40, 42." [at 324]

The Board of Appeals expressed the same concept when it held in Ex parte Grasenick and Gessner, 158 USPQ 624 (Patent Office Board of Appeals 1967), that:

"Improvement over prior art, even though it be simple...is patentable...." [at 624] [Emphasis added]

"This rejection is in error. An improvement over the prior art, even though it be simple... is patentable...." [at 624] [Emphasis added]

Attention is also respectfully directed in this regard to the decisions in Mercantile National Bank of Chicago et al v. Quest, Inc. et al., DC.N.D. Indiana, 166 USPQ 517; In re Shelby, 136 USPQ 220; In re Irani and Moedritzer, 166

USPQ 24, which all indicate that simplicity does not operate as a bar to patentability.

So it has been shown that the configuration of the present invention is not merely a matter of design choice but is significant and of critical importance. The CCPA held therefore that it must be considered in determining patentability, as held in In re Dailey and Eilers, 149 USPQ 47 (1976), where the Court held that the shape of a device must be considered in determining patentability, if the shape is significant:

"Appellants have presented no argument which convinces us that the particular configuration of their container is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious for the purpose of providing mating surfaces in the collapsed container of Matzen. See Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459." [Emphasis added]

Applicant respectfully draws the Examiner's attention to the fact that the Federal Circuit holds that relevant case law must be relied upon in determining obviousness – the determination of obviousness is a matter of law, as was decided in In re Deuel, 51 F.3d 1552, 1557, 34 USPQ.2d 1210 (Fed. Cir. 1995), where the court held:

"Obviousness is a question of law, which we review de novo, though factual findings underlying the Board's obviousness determination are

reviewed for clear error.
In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); In re Woodruff, 919 F.2d 1575, 1577, 16 USPQ2d 1934, 1935 (Fed. Cir. 1990)." [at 1214]
[Emphasis added]

And, as was upheld in Richardson-Vicks Inc. v. The Upjohn Co., 122 F.3d 1476, 44 USPQ.2d 1181 (Fed. Cir. 1997), where the court held:

"The difficulty with RVI's position is that, although the argument has merit when the issue is purely one of fact, it does not follow when the issue involves a question of law. It is black letter law that the ultimate question of obviousness is a question of law." See Graham v. Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966) (citing Great A. & P. Tea Co. v. Supermarket Equip. Co., 340 U.S. 147, 155, 87 USPQ 303, 309 (1950)); In re Donaldson Co., 16 F.3d 1189, 1192, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (in banc); Texas Instruments Inc. v. Unit States Int'l Trade Comm'n, 988 F.2d 1165, 1178, 26 USPQ2d 1018, 1028 (Fed. Cir. 1993). And we review that legal question without deference to the trial court. See Gardner V. TEC Sys. Inc., 725 F.2d 1338, 1344, 220 USPQ 777, 782 (Fed. Cir. 1984) (district court's conclusion on obviousness "is one of law

and subject to full and independent review in this court")." [at 1183] [Emphasis added]

Applying the case law discussed *supra* to the case at hand, applicant respectfully directs the Examiner to the seminal case of Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467, 15 L.Ed.2d 545, 86 S.Ct. 684 (1966), where the Supreme Court articulated the requirements for a *prima facie* holding of obviousness. The Patent Office has since set forth in MPEP 706.02, a three step requirement for establishing a *prima facie* case of obviousness.

The first step requires that the Examiner must set forth the differences in the claim over the applied references. The second step requires that the Examiner must set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter. And, the third step requires that the Examiner must explain why the proposed modification would be obvious.

The Federal Circuit requires that in order to satisfy the third step for establishing a *prima facie* case of obviousness, the Examiner must identify where the prior art provides a motivating suggestion to make the modification proposed in the second step for establishing a *prima facie* case of obviousness, as was decided in In re Jones, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992), where the court held:

"The Solicitor points out that, given the breadth of forms of dicamba (free acid, ester, or salt) disclosed by

Richter as having herbicidal utility, one of ordinary skill in the art would appreciate that the dicamba group has significance with respect to imparting herbicidal activity to dicamba compounds. Thus, the solicitor contends, one skilled in the art would have been motivated to use, with dicamba, substituted ammonium salts made from a known amine, such as the amine disclosed by Zorayan and Wideman, and would have expected such a salt to have herbicidal activity. Before the PTO may combine the disclosures of two or more prior art references in order to establish prima facie obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988). We see no such suggestion in Zorayan, which is directed to shampoo additives, nor Wideman, which teaches that the amine used to make the claimed compound is a byproduct of the production of morpholine. Nor does the broad disclosure of Richter fill the gap, for the reasons discussed above." [at 1943-44] [Emphasis added]

And, as was upheld in Gambro Lundia AB v. Baxter Healthcare Corporation, 110 F.3d 1573, 42 USPQ.2d 1378 (Fed. Cir. 1997), where the court held:

"...the record must provide a teaching, suggestion, or reason to substitute computer-controlled valves for the system of hoses in the prior art. The absence of such a suggestion to combine is dispositive in an obviousness determination. See SmithKline Diagnostics, Inc. v. Helena Lab. Corp., 859 F.2d 878, 886-87, 8 USPQ2d 1468, 1475 (Fed. Cir. 1998)" [at 1383] [Emphasis added]

In this same regard, the Examiner's attention is respectfully drawn to the decisions in Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 30 USPQ.2d 1377 (Fed. Cir. 1994); In re Fine, 837 F.2d 1071, 5 USPQ.2d 1596 (Fed. Cir. 1988); In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Federal Circuit, however, further requires that even if the prior art may be modified as suggested by the Examiner, the modification is not made obvious unless the prior art suggests the desirability of the modification, as was decided in In re Fritch, 922 F.2d 1260, 23 USPQ.2d 1780 (Fed. Cir. 1992), where the court held:

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless

the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902, 221 USPQ at 1127. "[at 1783] [Emphasis added]

In properly applying the Graham v. John Deere Co. test in light of, *inter alia*, In re Jones, Gambio Lundia AB v. Baxter Healthcare Corporation, and In re Fritch discussed *supra*, the Examiner must conduct a rigorous examination and analysis of the prior art. It would appear that the Examiner has not done so.

Neither Tetenes, Nelson et al., Roberts, Campbell, Juergens, Levey, Willinger – nor for that matter any of the references cited by the Examiner – make any motivating suggestion that, *inter alia*:

- regarding original claim 1 – now a part of amended claim 1 –, the device for holding a bucket of chum of Tetenes can be modified to include the drawstring to close the upper edge of the container as taught by Nelson et al., as suggested by the Examiner;
- regarding claim 2 – canceled and now a part of amended claim 1 –, the device for holding a bucket of chum of Tetenes as modified by Nelson et al. can be further modified to include the sheet material having a first plurality of orifices for permitting chum matter to pass through as taught by Levey, as suggested by the Examiner, and, the device for holding a bucket of chum of Tetenes as modified by Nelson et al. can be further modified to include the sheet material having a second plurality of orifices to thread the drawstring as taught by Campbell, as suggested by the Examiner;
- regarding claim 3 – canceled and now a part of amended claim 1 – the device for holding a bucket of chum of Tetenes as modified by Nelson et al., Levey, Campbell, and Juergens can be further modified to include the toroidal sleeve being fabricated by stitching first and second longitudinal edges of the longitudinal area

together as taught by Roberts, as suggested by the Examiner;

- regarding claim 5 – canceled and now a part of amended claim 1 – the device for holding a bucket of chum of Tetenes as modified by Nelson et al., Levey, Campbell, Juergens, and Roberts can be further modified to include the sheet material made of the flexible plastic material as taught by Nelson et al. and Roberts, as suggested by the Examiner;
- regarding claim 6 – canceled and now a part of amended claim 1 – the device for holding a bucket of chum of Tetenes as modified by Nelson et al. can be further modified to include the orifice in the bottom of the container permitting chum matter to pass through as taught by Willinger, as suggested by the Examiner;
- regarding claim 7 – canceled and now a part of amended claim 1 – the device for holding a bucket of chum of Tetenes as modified by Nelson et al. and Willinger can be further modified to include the circular bottom component permanently attached to the container by stitching as taught by Roberts, as suggested by the Examiner;
- regarding claim 8 – canceled and now a part of amended claim 1 – the device for holding a bucket of chum of Tetenes as modified by Nelson et al., Willinger, and Roberts can be further modified to include the welting sewn between the bottom portion and the lower edge of the cylindrical container as taught by Campbell, as suggested by the Examiner; and
- regarding claim 9 – canceled and now a part of amended claim 1 – the device for holding a bucket of chum of Tetenes as modified by Nelson et al., Willinger, Roberts, and Campbell can be further modified to include the sheet material made from plastic as taught by Nelson et al. and Roberts, as suggested by the Examiner.

The Examiner has directed the patentability inquiry towards the individual elements of the combination of the claimed invention and not to the subject matter as a whole, as required by the decision in Panduit Corp. v. Burndy

Corporation et al., 180 USPQ 498 (D.C.N.D. Illinois, E. Div.), where the court held:

"The inquiry into the patentability must be directed toward the subject matter as a whole and not to the elements of the claimed combination and their individual novelty, and therefore a patented combination which results in a more facile, economical or efficient unit, or which provides results unachieved by prior art structures, cannot be anticipated piecemeal by showing that the various elements of the invention are individually old.

The difference between the subject matter set forth in the Re. 26,492 patent and the subject matter of the cited prior art references as a whole would not have been obvious at the time the invention was made to a person of ordinary skill in the art to which such subject matter pertains, under 35 U.S.C. 103." [at 505]

[Emphasis added]

The CCPA held that such a combining of elements in a piecemeal manner in light of applicant's disclosure to show obviousness by the Examiner using applicant's own specification as though it were prior art is a direct violation of the basic mandate inherent in 35 U.S.C. 103, as was decided in In re Stephens, Wenzl, and Browne, 145

USPQ 656 (CCPA 1965), where the court reversed a rejection on a combination of references and held:

"In our consideration of the record in light of appellants' arguments, we find nothing which demonstrates that the examiner and the board erred in rejecting the claims. While we agree with appellants that references may not be combined indiscriminately and with guidance from appellants' disclosure to show that claims are unpatentable, we think the combination of references here is proper and adequately suggests the structure appellants have achieved." [at 657] [Emphasis added]

And, as was upheld in In re Kamm and Young, 172 USPQ 298 (CCPA 1972), where the court held:

"The rejection here runs afoul of a basic mandate inherent in section 103 - that a 'piecemeal reconstruction of the prior art patents in the light of appellants' disclosure' shall not be the basis for a holding of obviousness. In re Rothermel, 47 CCPA 866, 870, 276 F.2d 393, 396, 125 USPQ 328, 331 (1960)" [at 301] [Emphasis added]

Support for the Examiner's improper use of hindsight to modify the device for holding a bucket of chum of Tetenes to include the drawstring to close the upper edge

of the container as taught by Nelson et al. can be found at page 4, lines 7-8 of the Office Action, where it is disclosed:

"....to completely enclose the inside of the container to securely hold what is inside" [Emphasis added]

Applicant has exhausted the use of this advantage explicitly and/or inherently throughout the application as originally filed thus providing *prima facie* proof of the Examiner's use of improper hindsight. For example at page 4, lines 22-23 and page 7, lines 10-11 of the application, respectively, it is disclosed:

"....so as to captivate the frozen bucket of chum therein."

"....for pulling the upper edge closed and captivating the bucket 12 of chum 14 held within the device 10."

Support for the Examiner's improper use of hindsight to modify the device for holding a bucket of chum of Tetenes as modified by Nelson et al. to include the sheet material having a first plurality of orifices for permitting chum matter to pass through as taught by Levey can be found at page 5, lines 9-10 of the Office Action, where it is disclosed:

"....chum can pass through the container walls and into the water to attract fish."

Applicant has exhausted the use of this advantage explicitly and/or inherently throughout the application as originally filed thus providing *prima facie* proof of the

Examiner's use of improper hindsight. For example at page 4, lines 18-20 and page 7, line 24 of the application, respectively, it is disclosed:

"....so that chum matter can pass therethrough as the frozen cum melts and exits the device into the surrounding body of water so as to attract fish."

"....for permitting chum matter to pass through...."

Support for the Examiner's improper use of hindsight to modify the device for holding a bucket of chum of Tetenes as modified by Nelson et al. to include the sheet material having a second plurality of orifices to thread the drawstring as taught by Campbell can be found at page 5, lines 17-18 of the Office Action, where it is disclosed:

"....to securely hold the drawstring to the sheet material during use."

Applicant has exhausted the use of this advantage explicitly and/or inherently throughout the application as originally filed thus providing *prima facie* proof of the Examiner's use of improper hindsight. For example at page 7, lines 25-26 of the application, it is disclosed:

"....for cooperating with the drawstring 28 threaded therethrough."

And, support for the Examiner's improper use of hindsight to modify the device for holding a bucket of chum of Tetenes as modified by Nelson et al. to include the toroidal sleeve being fabricated by stitching first and second longitudinal edges of the longitudinal area together

as taught by Roberts can be found at page 6, lines 19-20 of the Office Action, where it is disclosed:

"...to ensure the toroidal sleeve is securely attached to the device."

And, support for the Examiner's improper use of hindsight to modify the device for holding a bucket of chum of Tetenes as modified by Nelson et al., Levey, Campbell, Juergens, and Roberts to include the sheet material made of the flexible plastic material as taught by Nelson et al. and Roberts can be found at page 7, lines 10-11 of the Office Action, where it is disclosed:

"...to make the device more lightweight and more inexpensive by using plastic instead of other heavier materials such as metals."

And, support for the Examiner's improper use of hindsight to modify the device for holding a bucket of chum of Tetenes as modified by Nelson et al. to include the orifice in the bottom of the container permitting chum matter to pass through as taught by Willinger can be found at page 7, line 22 to page 8, line 2 of the Office Action, where it is disclosed:

"...to allow the chum to be easily removed from the container in that gravity pulls it through the opening without any need for any other outside force."

And, support for the Examiner's improper use of hindsight to modify the device for holding a bucket of chum of Tetenes as modified by Nelson et al. and Willinger to

include the circular containing component permanently attached to the container by stitching as taught by Roberts can be found at page 8, lines 12-13 of the Office Action, where it is disclosed:

"...to make the device stronger and more durable for repeated used."

And, support for the Examiner's improper use of hindsight to modify the device for holding a bucket of chum of Tetenes as modified by Nelson et al., Willinger, and Roberts to include the welting sewn between the bottom portion and the lower edge of the cylindrical container as taught by Campbell can be found at page 9, line 3 of the Office Action, where it is disclosed:

"...to make the device stronger and more durable for repeated use."

And, support for the Examiner's improper use of hindsight to modify the device for holding a bucket of chum of Tetenes as modified by Nelson et al., Willinger, Roberts, and Campbell to include the sheet material made from plastic as taught by Nelson et al. and Roberts can be found at page 9, lines 9-10 of the Office Action, where it is disclosed:

"...to make the device as inexpensive and lightweight as possible."

Again, applicant has exhausted the use of all of these advantages explicitly and/or inherently throughout the application as originally filed thus providing *prima facie* proof of the Examiner's use of improper hindsight.

Applicant has provided clear and convincing evidence that neither Tetenes, Nelson et al., Roberts, Campbell, Juergens, Levey, Willinger – nor for that matter any of the references cited by the Examiner – accomplish applicant's result of providing an efficient device for holding a bucket of frozen chum that, inter alia:

- completely encloses the inside of the container to securely hold what is inside due to the drawstring closing the upper edge of the container;
- is allowed to be more effective and efficient in that the chum can pass through the container walls and into the water to attract fish due to the sheet material having the first plurality of orifices for permitting chum matter to pass through;
- securely holds the drawstring to the sheet material during use due to the sheet material having the second plurality of orifices to thread the drawstring;
- ensures that the toroidal sleeve is securely attached to the device making the device stronger and more durable due to the toroidal sleeve being fabricated by stitching first and second longitudinal edges of the longitudinal area of the sheet material together;
- is made more lightweight and more inexpensive by using plastic instead of other heavier materials such as metals due to the sheet material being made of a flexible plastic material;
- allows the chum to be easily removed from the container in that gravity pulls it through the opening without any need for any other outside force due to the orifice in the bottom of the container permitting chum matter to pass through;
- is made stronger and more durable for repeated use due to the circular bottom component being permanently attached to the container by stitching and welting being sewn between the bottom portion and the lower edge of the cylindrical container;
- is made as inexpensive and lightweight as possible due to the sheet material being made from plastic.

Therefore a holding of obviousness cannot be made out, as was decided by the Board of Appeals in Ex parte Tanaka, Marushima and Takahashi, 174 USPQ 38, where the Board held:

"Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art if the prior art devices do not accomplish applicant's result." [Emphasis added]

And, in In re Wright, 122 USPQ 522 (1959), where the Court held:

"...the mere aggregation of old elements that did not perform a different function is not a patentable invention, but that a novel combination of old elements which cooperate with each other to produce a new or useful result or a substantial increase in efficiency is patentable." [Emphasis added]

In this same regard, the Examiner's attention is respectfully directed to the decisions in In re Halleck, 164 USPQ 647 (CCPA 1970); Kockum Industries, Inc. v. Salem Equipment, Inc., 175 USPQ 81 (9th Cir. 1972).

In light of In re Miller, In re Fuetterer, In re Ludke and Sloan, In re Chu, Schnell et al. v. The Allbright-Nell Company et al., Ex parte Grasenick and Gessner, Mercantile National Bank of Chicago et al v. Quest, Inc. et al., In re Shelby, In re Irani and Moedritzer, In re Dailey and Eilers, In re Deuel, Richardson-Vicks Inc. v. The Upjohn Co., the Graham v. John Deere Co. test in view of, inter alia, MPEP 706.02, In re Jones, Gambro Lundia AB v. Baxter Healthcare Corporation, Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., In re Fine, In re

Keller, In re Merck & Co., Inc., and In re Fritch, Panduit Corp. v. Burndy Corporation et al., In re Stephens, Wenzl, and Browne, In re Kamm and Young, Ex parte Tanaka, Marushima and Takahashi, In re Wright, In re Halleck, and Kockum Industries, Inc. v. Salem Equipment, Inc. discussed supra, applicant attacks the Examiner's prima facie determination as being improperly made out and tending to support a conclusion of nonobviousness as is permitted by the Fritch Court at 1783 where the Federal Circuit held that the patent applicant may attack the Examiner's prima facie determination as improperly made out and tending to support a conclusion of nonobviousness:

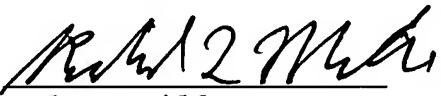
"In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art... [The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead to that individual to combine the relevant teachings of the references. The patent applicant may then attack the Examiner's prima facie determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness." [Emphasis added]

In view of the foregoing remarks and amendments, it is believed that this application is in condition for allowance.

Reconsideration and a favorable action are now kindly requested, and in the event that this specification or claims should require any further amendment, the kind assistance of the Examiner in entering an Examiner's amendment will be greatly appreciated. It is suggested that such amendment may be optionally supplemented by a phone conversation and confirmed by form PTOL-327, Box 4b, so as to expedite the formal allowance of this application.

Respectfully submitted,

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